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10/081,881	02/22/2002	Hirotomo Kitahara	Y-199	9950

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EXAMINER
KIM, SANG K

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/081,881
Filing Date: February 22, 2002
Appellant(s): KITAHARA ET AL., (LAMI CORPORATION, INC.)

MAILED

JUL 28 2004

GROUP 3600

James Walters, Reg. No. 35731
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 6/7/04 .

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-3, 5, 6 and 8 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 4 and 7 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

Applicant's admitted prior art, as shown in figures 5-7 and described on pages 1-4 of the specification.

(10) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn, U.S. Patent No. 3606187 in view of the admitted prior art shown in figures 5-7, and described on pages 1-4 of the specification.

Referring to claims 1-8, Hahn teaches a shaft 3 to support a core roll 25 with films wound around, wherein said shaft 3 having a groove 9 on a cylindrical surface along a longitudinal axial direction where roller bar 17 is set with both ends of the bar 19 incorporated with a roller bar and fixed by fittings 27 as shown in Fig. 1-4.

The recitation in the preamble of the claim that the lamination apparatus to form lamination layers of laminate film pasted on the surfaces of printed matter as posters, advertising fliers, computer output media or so, relates only to a possible or intended use of the device being claimed, but does not further structurally limit the device.

Hahn does not disclose a deformable tube of soft vinyl. It would have been obvious to use a deformable tube of soft vinyl in the apparatus of Hahn as suggested by the admitted prior art which teaches use of a soft material (rubber cord 82, page 3, lines 31 of the specification) which can be deformable, because a soft material would function in a substantially equivalent manner in the claimed invention to prolong the life of expectancy of the tube and avoid damage to the wound material. The use of vinyl rather than rubber would have been an obvious choice of design to one skilled in the art, since there is no particular disclosed criticality to the material, and either would function in substantially the same way. Having a separate bar inserted in the tube lacks any disclosed criticality and would have been obvious to hold the tube straight and clamp the material evenly.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kataoka, U.S. Patent No. 4496114 in view of the admitted prior art shown in figures 5-7, and described on pages 1-4 of the specification.

Referring to claims 1-8, Kataoka teaches a shaft 1 to support a core roll C with films wound around, wherein said shaft 1 having a groove 2, 11 on a cylindrical surface along a longitudinal axial direction where a roller is set with an axle inserted inside the roller and both end of the axle are fixed by fittings 3 as shown in Fig. 9.

The recitation in the preamble of the claim that the lamination apparatus to form lamination layers of laminate film pasted on the surfaces of printed matter as posters, advertising fliers, computer output media or so, relates only to a possible or intended use of the device being claimed, but does not further structurally limit the device.

Kataoka does not disclose a deformable tube of soft vinyl. It would have been obvious to use a deformable tube of soft vinyl in the apparatus of Kataoka as suggested by the admitted prior art which teaches use of a soft material which can be deformable, because a soft material would function in a substantially equivalent manner in the claimed invention to prolong the life of expectancy of the tube and avoid damage to the wound material. The use of vinyl rather than rubber would have been an obvious choice of design to one skilled in the art, since there is no particular disclosed criticality to the material, and either would function in substantially the same way.

This rejection is set forth in a prior Office Action, mailed on 7/30/03.

(11) Response to Argument

Applicant argues on pages 4-5 that Hahn is not teaching a deformable feature, and the desirability of the deformable feature is taught only by the applicant.

Applicant's statement that the desirability of the deforming feature is taught only by applicants is incorrect.

As set forth above, the admitted prior art teaches use of a soft material (rubber cord 82, page 3, lines 31 of the specification, see figures 5-7) which is a deforming feature, thus the desirability of the deforming feature is not taught only by applicants.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It would have been obvious to use a deformable tube of soft vinyl in the apparatus of Hahn as suggested by the admitted prior art which teaches use of a soft material (rubber cord 82, page 3, lines 31 of the specification) which can be deformable, because a soft material (e.g. rubber) would function in a substantially equivalent manner in the claimed invention to prolong the life of expectancy of the tube and avoid damage to the wound material. Also the general skill of a worker in the art to select a known material (such as a rubber material taught in the prior art) on the basis of its suitability for the intended use as a matter of obvious design choice to avoid damage to the wound material during the winding process.

Applicant argues on pages 5-9 that the rollers of Katoka are not intended to be flexible or deformable, thus it would not be obvious to modify with the rubber material as taught by the admitted prior art.

Applicant also argues that the tube is a soft vinyl.

As set forth above, Kataoka discloses the claimed invention except for a deformable tube of softy vinyl.

It would have been obvious to use a deformable tube of soft vinyl in the apparatus of Kataoka as suggested by the admitted prior art which teaches use of a soft material (rubber cord 82, page 3, lines 31 of the specification) which can be deformable, because a soft material (e.g. rubber) would function in a substantially equivalent manner in the claimed invention to prolong the life of expectancy of the tube and avoid damage to the wound material. Also the general skill of a worker in the art to select a known material (such as a rubber material taught in the prior art) on the basis of its suitability

for the intended use as a matter of obvious design choice to avoid damage to the wound material during the winding process.

Apparatus of Kataoka can be replaced with flexible or deformable rollers. The reason for not making the rollers flexible or deformable is to be able to support a heavy-weight roller. Thus, changing the rollers to become flexible or deformable will only accommodate to support a light-weight roller. Therefore, even though the rollers of Katoka are not intended to be flexible or deformable, it does not mean that it cannot be flexible or deformable.

The use of vinyl rather than rubber would have been an obvious choice of design to one skilled in the art, since there is no particular disclosed criticality to the material, and either would function in substantially the same way, (i.e. a soft vinyl material is a particular type of rubber).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

SK
July 22, 2004

Conferees
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